

32692
Customer Number

Patent
Case No.: 57135US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

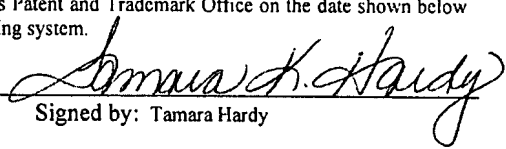
First Named Inventor: KRECH, JOHN E.
Application No.: 09/990601 Confirmation No.: 3879
Filed: November 21, 2001
Title: PLASTIC SHIPPING AND STORAGE CONTAINERS AND COMPOSITION AND
METHOD THEREFORE

REPLY TO EXAMINER'S ANSWER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR § 1.8(a)]
I hereby certify that this correspondence is being:
☒ transmitted to United States Patent and Trademark Office on the date shown below
via the Office electronic filing system.

11/7/2007
Date


Signed by: Tamara Hardy

Dear Sir:

This is a reply to the Examiner's Answer to the appeal brief mailed on September 10, 2007.

Fees

- ☐ Any required fee will be made at the time of submission via EFS-Web. In the event fees are not or cannot be paid at the time of EFS-Web submission, please charge any fees under 37 CFR § 1.17 which may be required to Deposit Account No. 13-3723.
- ☐ Please charge any fees under 37 CFR §§ 1.16 and 1.17 which may be required to Deposit Account No. 13-3723. (One copy of this sheet marked duplicate is enclosed.)
- ☒ Please charge any additional fees associated with the prosecution of this application to Deposit Account No. 13-3723. This authorization includes the fee for any necessary extension of time under 37 CFR § 1.136(a). To the extent any such extension should become necessary, it is hereby requested.
- ☒ Please credit any overpayment to the same deposit account.

The following comments are in response to Examiner's Answer (the "Answer") and are in addition to those already presented in Appellants' Appeal Brief (the "Brief") and during prosecution. If a point raised by the Examiner in the Answer is not addressed herein, it is not an admission that Appellants agree with the Examiner's position, instead, it only means that the Appellants believe that the point was adequately addressed in the Brief or in prosecution and for the sake of brevity, need not be addressed in this Reply.

Turning to the Examiner's comments beginning on page 18 of the Answer, Appellants reply as follows:

- When the Examiner states that "intermediate molecules used to make a chemical composition generally do not exist in the final form of the chemical composition" (page 18-19), he seems to suggest that some Oishi et al diguanamines may not be halogenated, and hence, that Oishi et al's **lack** of teaching about the need to use **only** non-halogenated fire retardants is cured. Not only is the Examiner's position speculative with respect to the final form of the diguanamines, but it does not change the fact that Oishi et al is entirely silent about the need to use **only** non-halogenated fire retardants to make fire resistant articles. The Examiner further asserts (on page 20, last paragraph and text bridging page 21) that Oishi et al need not teach the use of "only halogen-free flame retardants" because "Oishi disclose[s] halogen-free flame retardants". However, from a legal point of view, the Examiner's position is incorrect. Mere possibilities cannot substitute for a clear teaching, and it is clear that Oishi et al does not teach or suggest the use of only non-halogenated flame retardants. Rather than cure this deficiency, for example, by offering other prior art combinable with Oishi et al that provides the missing teaching, the Examiner simply suggests that such a deficiency is not important. When the prior art is viewed through the lens of hindsight, things which are not obvious may seem obvious, but that is the bias that the Examiner must ensure he does not apply when making obviousness rejections, unfortunately, this issue is but one of several in this case where the Examiner's view of the art is biased by hindsight. Appellants have not claimed every plastic pallet, or even every fire resistant plastic pallet. They have claimed specific fire resistant plastic pallets which are neither disclosed, taught, or suggested by Oishi et al alone or in combination with any of the other prior art cited by the Examiner. Accordingly, Appellants maintain that Oishi et al does not teach, disclose, suggest or enable pallets made from fire resistant compositions comprising only non-halogenated fire retardants, and that the Examiner has failed to establish that Appellants' invention is obvious.

- Appellants have argued in the Brief and during prosecution that Oishi et al does not teach the use of only non-halogenated resins. On page 19, first full paragraph of the Answer, the Examiner seems to be correcting an error he perceives Appellants made in the Brief when they cited Oishi et al text about the use of halogenated resins. However, the text referenced by the Examiner (i.e., col. 7, lines 27 and col. 8, lines 54-55 and 66-67) was cited by Appellants to show that Oishi et al teaches that its diguanamines could be made from halogenated compounds. Appellants cited col. 29, lines 40-49 to show that Oishi et al teaches that its compositions can be prepared from halogenated resins. For clarification, Appellants do not maintain that one of ordinary skill in the art would read only a line here or there in col. 29 of Oishi et al to understand how to prepare the invention group 2 compositions. Appellants cited specific text from Oishi et al for the convenience of the Board and the Examiner. However, a fair reading of Oishi et al will include the teaching at lines 40-44 about halogenated resins. Accordingly, Appellants maintain that Oishi et al does not teach, suggest or enable plastic pallets made from compositions containing **only** non-halogenated resins, and the Examiner has not cured the inherent deficiencies of Oishi et al in that regard so the obviousness rejections of the claims must fail.
- In response to the Examiner's arguments about the end uses of Oishi et al's compositions (starting at page 19, second full paragraph through page 21, first full paragraph), and whether or not one of ordinary skill in the art would readily substitute an invention group 2 composition for an invention group 3 application, Appellants again point out that Oishi et al is directed to three distinctly and separately described invention groups, each utilizing a common class of diguanamine materials. Each of the invention groups is described in its own "Technical Field", "Background Art", "Disclosure of The Invention" and "Best Mode For Carrying Out The Invention" sections of Oishi et al. For each invention group, Oishi et al teaches specific formulations and end uses. The very way Oishi et al organized its disclosure teaches away from the wholesale substitution of compositions from one invention group for uses in another. In the

Answer, the Examiner suggests that the diguanamines used in Oishi et al's second invention group compositions overlap with those taught to be useful in the third invention group. Because Appellants do not understand exactly what Oishi et al disclosure in cols. 68 and 69 the Examiner is relying upon to support his assertion, they cannot specifically comment on it, but nevertheless his argument does not take into account the very significant differences between the invention group 2 compositions and the invention group 3 compositions. The diguanamines used in all of the Oishi et al compositions belong to a broad, common class, but that alone would not motivate one of ordinary skill in the art to substitute an invention group 2 composition, which are taught to be primarily useful in the manufacture of microspheres, for an invention group 3 composition, which are taught to be useful for molded articles. What reasonable rationale exists to substitute a composition (i.e., invention group 2 composition) which on its face is less appropriate for use in certain molded articles, for a composition which the same reference teaches is appropriate for those same molded articles? The Examiner's conclusion that one of ordinary skill in the art would seek to substitute one composition for another without some clear teaching or motivation to do so seems illogical and ignores the teaching of Oishi et al as a whole.

- The Examiner argues (on page 20, first full paragraph) that U.S. Pat. No. 6,344,508 ("Endo") is evidence that the pallet structure is a well known structure to those of ordinary skill in the art of transportation equipment or of containers. The Examiner alleged that a pallet is a piece of transportation equipment within the teaching of Oishi et al even though Oishi et al does not "explicitly teach a pallet". The Examiner further alleges that Appellants define a pallet as a container, so pallets must fall within the teaching of Oishi et al's teaching of containers. The Oishi et al text in question is at column 69 lines 1-6. It actually states that the Oishi et al invention group 3 compositions can be used in: "...fields such as household appliances, **parts and components of transportation equipments such as automobiles**, industrial parts and components, tanks, containers, apparatuses, and electrical parts and components..." (emphasis added). The plain meaning of the language "parts and

components of transportation equipments” cannot mean that pallets are parts and components of “transportation equipments” if “transportation equipments are things like automobiles. “Containers” are not clearly pallets either. In fact, “containers”, as taught by Oishi et al, could be a wide range of vessels provided they are not tanks (which are separately listed). However, a teaching about such containers is still a far cry from teaching that Oishi et al invention group 3 compositions, or any Oishi et al composition for that matter, would be useful in a pallet. To make the connection, the Examiner inappropriately relies on Appellants’ own invention disclosure, which is neither prior art nor an admission. Furthermore, because Appellants are free to be their own lexicographers, it is a dangerous presumption to assume Appellants’ language must be equivalent to language in the prior art describing a different invention and reliance of such presumption should be further justified. Finally, the Examiner did not even characterize Appellants’ language correctly. Appellants do not characterize a pallet as a “container”. Instead, Appellants’ actual language is: “[p]lastic shipping containers, including pallets”. Oishi et al says nothing about plastic shipping containers, and it is unclear why one of ordinary skill in the art would think of “plastic shipping containers” when he sees a teaching about “containers” other than “tanks”. Appellants maintain that Oishi et al does not teach, suggest, disclose or enable one of ordinary skill in the art to make a fire resistant pallet made from non-halogenated fire retardants and resins, and that neither Appellants’ own application nor Endo (which teaches different flame-retardant resin compositions and articles) cure the deficiencies of Oishi et al.

- On Page 21 (first full paragraph), the Examiner suggests that Appellants have misunderstood his reliance on Endo. He indicates that it is not relevant whether or not one of ordinary skill in the art would seek to replace (or even modify) Endo’s compositions with those taught in Oishi et al. Instead, he argues that Endo is presented only to show the pallet structure is a well known structure to one of ordinary skill in the art of transportation equipment or of containers (Appellants assume that this would not be the same person since the applications are so technically different), and that one would form “the part or component of

transportation equipment or container of Oishi et al in the form of a pallet". Appellants appreciate the additional clarification of the Examiner's position because we previously found the Examiner's reliance on Endo and hence the obviousness rejections relying on Oishi et al and Endo unclear. However, Appellants still maintain that while Oishi et al teaches certain fire resistant compositions, it does not teach pallet compositions or pallets (which the Examiner has stated himself), and in particular, it does not teach the compositions or pallets claimed by Appellants. Is it reasonable to believe that one of ordinary skill in the art would understand a transportation equipment or component of the same, as taught by Oishi et al to be a pallet? As explained above, Appellants believe that the answer to that question is no. Alternatively, is it reasonable to believe that one of ordinary skill in the art would understand a container as disclosed by Oishi et al to be a pallet? Again, Appellants do not think so. Further, which teaching would one of ordinary skill use, the disclosure about parts and components of transportation equipments or the disclosure about containers which are not tanks? Apparently, the Examiner is not confident enough about his argument to pick one application and rely upon it. Additionally, as to the disclosure about containers, the Examiner obviously is not confident enough to rely only the teachings of Oishi et al and Endo because he continues to inappropriately rely upon text selected out of context from Appellants' own application to support his rejections. However, in any case, Endo does not cure the deficiencies of Oishi et al because, among other things, Endo does not teach, disclose or suggest the use of the compositions employed by Appellants (as also admitted by the Examiner on page 20, first full paragraph of the Answer) to make pallets, nor does it provide a teaching that one of ordinary skill in the art would combine with those of Oishi et al to cure its deficiencies.

In summary, Oishi et al does not teach what the Examiner has alleged, and Appellants' application does not say what the Examiner alleges. The Examiner has selected language out of context and used hindsight to interpret it to support his rejections, however, such interpretations either conflict with the teachings of the documents as a whole or are contradicted by the plain meaning of the language when it is taken in context. The use of Appellants' own application to

justify the Examiner's interpretation of the art is clearly improper. So for all the reasons given herein and the reasons argued in the Brief and during prosecution, Appellants' respectfully submit that the rejections of their claims are improper and request that all rejections should be withdrawn and their application allowed.

Respectfully submitted,

11/7/07
Date

By: Eloise J. Maki
Eloise J. Maki, Reg. No.: 33,418
Telephone No.: 651-737-8459

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833